

REMARKS

Claims 3-6, 8, 14, 21, 22, and 27-50 are pending. Amendment of claim 8 is proposed. Claims 3, 4, 14, 21, 22, 27-37, 43-45, 49 and 50 are withdrawn as being drawn to non-elected subject matter. No new matter has been incorporated into the application as a result of the amendment made herein.

Entry of the amendment to claim 8 is requested under 37 CFR 1.116, as the amendment is made in response to the rejection under 35 U.S.C. §112, second paragraph, and is directed only to the formal matter raised therein. As such, the amendment raises no new issues. In the alternative, entry of the proposed amendment is requested to place the claims into better form for consideration on appeal.

**Rejection under 35 U.S.C. §112**

Claims 8 and 46-48 stand rejected under 35 U.S.C. §112, second paragraph as indefinite for failure to provide proper antecedent basis for the claim term “the distal end”. Applicants submit that the proposed amendment moots this basis for rejection.

**Rejection under 35 U.S.C. §102(b) over Taylor et al.**

Claims 5, 6, 8, 38-42 and 46-48 stand rejected under 35 U.S.C. §102 (b) as anticipated by Taylor et al. (U.S. Patent No. 6,394,951). Applicants traverse this basis for rejection and respectfully request reconsideration and withdrawal thereof.

The deficiencies of Taylor et al. were discussed at length in Applicants' previous response of August 23, 2007, and are reiterated herein.

The Office Action states that Taylor teaches a tissue approximation device having two elongate arms 3, an attachment means 144, adhesive pads 4 movably connected by elements 18 and 19 on at least a portion of the elongate

arms, and a locking means 181 as claimed. Reference is made to the embodiments represented in Figs. 31a and 31b. At page 4 of the outstanding Office Action, the Examiner states “the adhesive pad is rotatable around the ball about at least two axes (slight rotation is possible along two axes)”.

Applicants respectfully traverse the Examiner’s finding on this point, which is entirely unsupported by the language in Taylor et al. describing elements 18 and 19 (col. 14, lines 20-37). Taylor et al. describe Fig. 2 as having “snap-in member 16”, which has a post 18 formed on top of member 16, and a port 19 disposed in the body of contact member 1. Nowhere do Taylor et al. disclose or suggest that snap-in member 16 should be rotatable, or even movable, as suggested by the Examiner. The Examiner’s finding is entirely unsupported by the cited reference, and as such, the rejection under 35 U.S.C. §102(b) is literally unfounded. Withdrawal of the rejection is requested on this basis alone.

At page 6 of the outstanding Office Action, the Examiner opines:

The applicant generally argues the following regarding the pending claims (many arguments were directed to claims that were restricted and have since been withdrawn): Taylor does not teach a movable ball and socket connection. The examiner’s position is that the ball and socket (18 and 19, Fig. 2) of Taylor is movable to a small degree, it is capable of being moved. (Emphasis added).

The Examiner’s position is speculative at best, and disingenuous at worst. Taylor et al. never describe elements 18 and 19 as a “ball and socket”, but instead as parts of a “snap-in member”. The Examiner’s characterization of elements 18 and 19 as a “ball and socket” is strictly an impermissible hindsight reconstruction of the present invention, derived from reading of the present specification. The only manner in which elements 18 and 19 could cooperate as a “ball and socket” would be if post 18 were not inserted completely through port 19, such that the surface of post 18 would swivel against the inner ring of port 19, in which case snap-in member 16 would not be “affixed” to contact member 1, as required in Taylor et al. (col. 14, line 21).

Likewise, the Examiner's position that Taylor's elements 18 and 19 would be movable relative to one another is unfounded, both in the Taylor et al. specification (as stated above), and from the view of the skilled artisan. In view of the extremely delicate nature of the surgery to be performed as set forth in Taylor et al., i.e. open heart surgery, the skilled artisan would not expect the Taylor et al. device to be designed or made such that unwanted movement could occur. Such movement would be very detrimental to the surgical procedure, where the utmost accuracy in positioning the Taylor et al. device would be required.

Additionally, the Examiner's proposition that the Taylor et al. device would be "movable to a small degree" ignores the plain language of claim 8, wherein Applicants specify "the adhesive pad is rotatable around the ball about at least two axes". Even a cursory review of Taylor et al.'s Fig. 2 would reveal that no rotation, let alone rotation about at least two axes would be available. Presuming that the x and y axes are the horizontal and vertical axes within the plane of the page, and that the z axis would extend out of the page, snap-in member 16 is clearly restrained from rotation about the z axis by the length of contact member 1, and restrained against rotation about the y axis by the combination of both snap-in posts 18, i.e. there is no pivot point for such rotation.

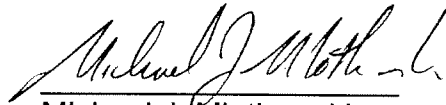
The Examiner's stated position that the device would be movable to a small degree must presume a sloppy fit of the snap-in member and posts 18 within ports 19. As stated above, such an interpretation of the Taylor et al. device is unwarranted, not only by the literal language of the reference, but also by the expectations of the skilled artisan as to the requirements for devices used in extremely exacting open heart surgery. Further, the skill in the arts of molding (if made of plastic) or machining is well-beyond the point of making a sloppy fitting snap-in connection, as presumably argued by the Examiner. There is no reason to expect that posts 18 would be movable within ports 19 of Taylor et al.

Withdrawal of the rejection is requested.

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It is submitted that the application is in condition for allowance. Should further issues requires resolution prior to allowance, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Michael J. Mlotkowski", written over a horizontal line.

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